

REMARKS

Claims 1 - 4 are pending, with claims 1 - 4 having been rejected, as discussed in detail below.

Claims 3 and 4 stand rejected under 35 U.S.C. 112, second paragraph. It is the Examiner's assertion that there is lack of antecedent basis for the wording "the maximum speed" as recited in claims 3 and 4 and that this lack of 'literal' antecedent basis makes claims 3 and 4 indefinite to the point of not complying with the requirements of 35 U.S.C. 112, second paragraph. Reconsideration of this rejection is respectfully requested. Antecedent basis need not always be 'literal', as it may be inherent. The Examiner is referred to Section 2173.05(e) of the Manual of Patent Examining Procedure, which states:

"Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. . . . Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

As claim 1, lines 11 - 13, require that the carriage travels at different speeds, (namely, a first speed and second speed, with the second speed being slower than the first speed), there **inherently** is a "maximum" speed of the carriage. The lack of literal antecedent basis for the wording "the maximum speed of the carriage" does **not** make claims 3 and 4 indefinite, since one of ordinary skill in the art would be able to discern what is "within" versus "outside" the claim boundary of claims 3 and 4. Therefore, claims 3 and 4 fully comply with the requirements of 35

U.S.C. 112, second paragraph. Thus, it is respectfully requested that the rejection of claims 3 and 4 under 35 U.S.C. 112, second paragraph, be reconsidered and withdrawn.

Claims 1 and 2 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota (U.S. 7,072,082) in view of Lee et al. (U.S. 6,829,065). Reconsideration of this rejection is respectfully requested. The Examiner asserts that, in Lee et al., item 3A discloses a member that connects the bottom surfaces of a platen glass and an end glass being "in the form of a sheet". However, item 3A in Fig. 1A of Lee et al. is disclosed **not** as being "a sheet", but as being "double face tape". At col. 1, lines 33 - 34, of Lee et al. it is stated:

"One face of the double face tape 3a is sticky to a rim of the glass sheet 2a".

Perhaps the Examiner intended to rely on the "glass sheet 2a" in Fig. 1A of Lee et al. (instead of item 3A) as suggesting to one of ordinary skill in the art to make a member that connects bottom surfaces of a platen glass and an end glass of a scanner being in the form of a sheet. Even if this were the Examiner's intent, the rejection would be clearly improper in that the Lee et al. scanner does not employ **two** glass surfaces that include a platen glass and an end glass. Therefore, in Lee et al. there is no need for a member that connects bottom surfaces of the platen glass and the end glass. Thus, the combined teachings of Yokota and Lee et al. would **not** have made obvious that which is claimed in base claim 1, since there is no suggestion in either reference to make a member that connects bottom surfaces of a platen glass and an end glass in the form of a sheet. As claim 2 depends directly from claim 1, claim 2 is patentable over Yokota (U.S. 7,072,082) in view of Lee et al. (U.S. 6,829,065) at least for the reason, discussed above, that claim 1 is patentable over these references.

Having pointed out that the rejections of record are improper, it is respectfully requested

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that, unless more pertinent prior art is found, an early Notice of Allowability be provided.

Respectfully submitted,

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